The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN C. MILLER and RAYMOND C. STURM

Appeal No. 2006-0100
Application No. 10/071,354

ON BRIEF

Before WARREN, WALTZ, and KRATZ, **Administrative Patent Judges.**
WALTZ, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's refusal to allow claims 1, 5, 6, 8 through 10, and 12 through 29 as amended subsequent to the final rejection (see the amendment dated Apr. 22, 2004, entered as per the Advisory Action dated May 6, 2004). Claims 1, 5, 6, 8-10 and 12-29 are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

achieve pilling resistance, soil release, strength and abrasion resistance properties (Brief, page 2).[1] Representative independent claim 1 is reproduced below:

> 1. A nonwoven textile article that has been chemically modified to achieve pilling resistance, soil release, strength, and abrasion resistance properties, wherein the textile article is comprised of spun-bonded continuous multi-component fibers that are splittable along their length by mechanical or chemical action, and wherein said fibers are selected from the group consisting of polyester, nylon, and combinations thereof, and wherein the textile article is a fabric and said fabric achieves a minimum pilling resistance rating of "B" according to ASTM D4970 for Martindale Pilling and Marks & Spencer Test Method P17 and wherein said fabric further achieves a minimum soil release rating of 3.0 according AATCC Method 130-2000 after 1 wash cycle.

In addition to Application No. 10/071,297, the examiner has relied upon the following prior art references as evidence of unpatentability:

Vigo et al. (Vigo)	5,897,952	Apr. 27, 1999
Groten et al. (Groten)	5,899,785	May 04, 1999

The claims on appeal stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 21 and 42 of co-pending Application

[1]We refer to and cite from the Brief dated Dec. 14, 2004.

No. 10/071,297 (Answer, page 3).[2] The claims on appeal also stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Groten (Answer, page 3). Finally, the claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Vigo in view of Groten (Answer, page 4).

Based on the totality of the record, including due consideration of appellants' arguments and evidence in the Brief, we *affirm* all of the rejections on appeal essentially for the reasons stated by the examiner in the Answer, as well as those reasons set forth below.

OPINION

A. The Rejection under Obviousness-type Double Patenting

Appellants do not contest the examiner's rejection of the claims on appeal for obviousness-type double patenting over the claims of Application No. 10/071,297 (now U.S. Patent No. 6,673,125). Appellants state that a terminal disclaimer will be filed once all other issues of patentability have been resolved

[2]This rejection is not now provisional since Application No. 10/071,297 has issued as U.S. Patent No. 6,673,125 on Jan. 6, 2004. We also note that the only product claim in this patent is now claim 17.

(Brief, page 4). Accordingly, we summarily affirm the examiner's rejection.

B. The Rejection under § 102(b)/§ 103(a)

The examiner finds that the nonwoven fabric disclosed by Groten is identical to appellants' preferred nonwoven textile material before chemical modification (Answer, page 3; Brief, page 5; specification, page 1, ll. 15-19; and the sentence bridging pages 4-5). The examiner further finds that Groten teaches that this fabric can be chemically treated with anti-pilling treatments, hydrophilic treatments (which would improve soil release properties), and modification of its feel and luster, as well as modifications of its external appearance such as dyeing or printing (citing col. 5, ll. 1-9). From these findings, the examiner concludes that the fabric of Groten would inherently achieve improved pilling resistance, soil release, strength and abrasion resistance properties due to these chemical modifications (Answer, page 3), and these properties would be the same or substantially similar to the claimed "minimum pilling resistance rating" and "minimum soil release rating" (Answer, page 4; see claim 1 on appeal). The examiner bases this conclusion on the similar nonwoven textile articles of Groten and appellants' claimed

invention, as well as the similar production steps used to produce the finished article (i.e., the chemical modification).

Appellants argue that it has been clearly demonstrated that the untreated control fabric of the Examples is the fabric described in Groten, and that the claim limitations are not inherent in the untreated fabric of Groten as shown by the test results presented in Table 1 and Table 3 (Brief, page 6). As discussed above, we agree with appellants that the untreated fabric of Groten is the basis of the claimed article before it has been "chemically modified." We also agree with appellants that the "claim limitations are not inherent to the untreated fabric" of Groten (Brief, page 6, underlining added). However, as explained by the examiner (Answer, page 6), Groten explicitly teaches that this untreated fabric may be subjected to chemical modification to improve its properties, including pilling resistance and soil release (col. 5, ll. 1-9).

Appellants argue that Groten fails to specifically teach "each and every" limitation of the claimed invention, and the test results show that the fabric of Groten does not achieve the same results as the claimed fabric (Brief, pages 6-7). These arguments are not persuasive. As discussed above, appellants' test results in their specification are compared to the untreated fabric of

Groten as a control while the chemically treated product of Groten has been relied upon by the examiner in this rejection (Answer, pages 6-7). As held by a predecessor of our reviewing court:

> [I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. [Citation omitted]. This burden ... is applicable to product and process claims reasonably considered as possessing the allegedly inherent characteristics.[3]

We determine that the examiner has reasonably established that the products of Groten and appellants' claimed subject matter are identical or substantially similar, and thus the burden has shifted to appellants to establish that the products are not the same or substantially similar. As discussed above, the only evidence offered by appellants compares the untreated fabric of Groten with appellants' treated fabric and thus appellants' burden has not been met.

[3] *In re Best,* 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), quoting *In re Swinehart,* 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971); *see also In re Spada,* 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990).

Appellants argue that Groten fails to teach, in any of its examples, the specific chemicals needed to achieve such finishing treatments (Brief, page 7). This argument is not well taken since, as noted by the examiner (Answer, page 7), the claims on appeal do not specify any chemicals or combinations of chemicals. Furthermore, the specific chemicals used by Groten need not be disclosed in the patent specification if the chemicals were well known in the art for their function.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a prima facie case of anticipation/obviousness which has not been adequately rebutted by appellants' evidence and arguments. Therefore we affirm the examiner's rejection of the claims on appeal under sections 102(b)/103(a) over Groten.

C. The Rejection under § 103(a)

The examiner finds that Vigo discloses a "chemical treatment" which produces a fabric having improved soil release, durable press, resistance to static charge, abrasion resistance, pilling resistance, and water absorbency properties (Answer, page 5). The examiner also finds that Vigo teaches that this chemical treatment can be applied to all types of fibrous constructions, including nonwoven fabrics (*id.*, citing col. 1, ll. 60-65). As previously

found, Groten discloses a spun-bonded fabric which can be chemically treated to achieve many of the same properties desired by Vigo (Answer, page 5). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art to use the fabric taught by Groten with the chemical treatment used by Vigo (*id.*). We agree.

Appellants argue that there is no motivation or suggestion for combining the references as proposed (Brief, page 9). Additionally, appellants argue that Vigo teaches a chemical treatment that is "far different" from that taught by appellants, namely appellants employ components such as fluorocarbon, high density polyethylene, long chain alcohols, and silicone, while Vigo employs glyoxal reactants with polyethylene glycol and sulfonic acid (*id.*).

These arguments are not persuasive. The examiner has set forth a reasonable motivation to combine the references (Answer, page 5), especially noting that the chemical treatment of Vigo can be applied to all fibrous constructions, including the nonwoven fabrics of Groten (Vigo, col. 1, ll. 60-65). As also noted by the examiner (Answer, page 8), appellants do not claim any specific combination of chemicals, and thus the "chemical treatment" of

Vigo reads on the "chemically modified" language recited in claim 1 on appeal.

For the foregoing reasons as well as those reasons stated in the Answer, we determine that the examiner has established a prima facie case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of the evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the examiner's rejection of the claims on appeal under section 103(a) over Vigo in view of Groten.

D. Summary

The rejection of claims 1, 5, 6, 8-10 and 12-29 under the judicially created doctrine of obviousness-type double patenting over the claims of Application No. 10/071,297 (U.S. Patent No. 6,673,125) is affirmed.

The rejection of claims 1, 5, 6, 8-10 and 12-29 under 35 U.S.C. § 102(b)/§ 103(a) over Groten is affirmed. The rejection of claims 1, 5, 6, 8-10 and 12-29 under 35 U.S.C. § 103(a) over Vigo in view of Groten is affirmed.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1(iv)(2004).

AFFIRMED

CHARLES F. WARREN)
Administrative Patent Judge)
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THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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